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OFFICE OF PETITIONS

In re Patent of Ohta et al. :
Patent No. 7,342,014 :
Issue Date: March 11, 2008 :
Application No. 10/773,344 :
Filed: February 9, 2004 : FINAL AGENCY DECISION
Docket No. 17620-105007 :
Title: DIAMINE DERIVATIVES :
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This is a decision on the REQUEST FOR RECONSIDERATION OF DISMISSAL OF REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. 1.183 AND OF DISMISSAL OF REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d), filed November 16, 2010, requesting that the requirements of 37 CFR § 1.705(d) be waived to permit reconsideration of the patent term adjustment in the above-identified patent more than two months after the issuance of the patent. Alternatively, patentees request that the requirements of the *Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. §154(b) (2) (A)* be waived to permit the reconsideration of the patent term adjustment of the above-identified patent later than 180 days after its issuance.

This is also a decision on the request that the revised patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred fifty-three (753) days. Patentees request this correction on the basis that the Office took in excess of three years to issue the patent and in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

The petition under 37 CFR 1.183 is hereby **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See, MPEP 1002.02.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **dismissed as untimely filed**.

37 CFR 1.705(d) provides that:

If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section.

On February 1, 2010, the USPTO published a Federal Register notice that, *inter alia*, announced a limited waiver of the two-month deadline for filing a petition for reconsideration of a PTA determination under 37 CFR § 1.705(d). See *Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. §154(b)(2)(A)*, 75 Fed. Reg. 5043 (Feb. 1, 2010) (notice).

Specifically, patent owners were permitted to request recalculation of a patent's PTA in view of the Federal Circuit decision *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010) up to 180 days after the grant of the patent. The USPTO determined not to accept any requests for PTA recalculation initially filed more than 180 days after patent grant, however, in view of the statutory judicial-review provisions of 35 U.S.C. § 154(b)(4), which require that any civil action to challenge the USPTO's PTA determination be brought within 180 days of patent grant. The USPTO believes that the statutory 180-day period for seeking court review of the USPTO's PTA determinations, particularly in view of the six-year statute of limitations that otherwise is applicable for actions under the Administrative Procedure Act, indicates a congressional intent that PTA issues be resolved after a patent issues. The USPTO does not consider it likely that Congress created a scheme under which the time period to seek initial USPTO review of a PTA determination extends beyond the time period provided for a dissatisfied patentee to seek judicial review of the USPTO's PTA determination. Thus, the

USPTO believes that the 180-day period in 35 U.S.C. § 154(b)(4) represents the outer limit on the USPTO's ability to conclude its PTA determination.

On March 11, 2008, the above-identified application matured into U.S. Patent No. 7,342,014 with a revised patent term adjustment of 357 days. No request for reconsideration of the patent term adjustment indicated in the patent was filed within two months of the date the patent issued. The first request for reconsideration of patent term adjustment and petition under 37 CFR 1.183 were filed on February 2, 2009. This request was filed over 10 months after the patent issued. As this request was filed more than 180 days after patent grant, it was properly dismissed. It is appropriate to deny a renewed request for waiver, under the same reasoning.

In view thereof, the time requirement of 37 CFR 1.705(d) is not met. The petition for recalculation/reconsideration of the USPTO's PTA determination for U.S. Patent No. 7,342,014 is dismissed as untimely filed.

Prior receipt of the \$400 fee required for consideration of the petition under 37 CFR 1.183 is acknowledged.

Prior receipt of the \$200 fee for consideration of the request for reconsideration of patent term adjustment is acknowledged.

Telephone inquiries specific to this decision should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.



Anthony Knight
Director
Office of Petitions